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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* STEVEN C. MONROE

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Appeal 2008-0845  
Application 09/894,904  
Technology Center 2100

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Decided: July 24, 2008

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Before JAMES D. THOMAS, JEAN R. HOMERE,  
and STEPHEN C. SIU, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is under 35 U.S.C. § 134(a) from the Examiner's final rejection  
of claims 21 through 50. We have jurisdiction under 35 U.S.C. § 6(b).

As best representative of the disclosed and claimed invention, independent claim 21 is reproduced below:

21. A method for maintaining a whois database, comprising:

extracting a plurality of unique identifiers from an audit file, each unique identifier corresponding to a modified or deleted domain name record within a registrar database; and

for each unique identifier;

determining whether a first domain name record that corresponds to the unique identifier exists within the registrar database,

if the first domain name record exists, retrieving the first domain name record from the registrar database,

determining whether a second domain name record that corresponds to the unique identifier exists within the whois database,

if the second domain name record exists, retrieving the second domain name record from the whois database,

comparing the first domain name record to the second domain name record, and

updating the second domain name record, within the whois database, based on the first domain name record.

The following reference is relied on by the Examiner:

Schneider US 6,760,746 B1 Jul. 6, 2004  
(filing date Aug. 31, 2000)

Claims 21 through 50 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Schneider.

Rather than repeat the positions of the Appellant and the Examiner, we refer to the Brief and Reply Brief for the Appellant's positions and to the Supplemental Answer filed on July 12, 2007, for the Examiner's positions.

## OPINION

We reverse.

Since we essentially agree with the views expressed by Appellant in the Reply Brief, we reverse the rejection of all claims on appeal under 35 U.S.C. § 102. In a nutshell, we also agree with Appellant's views that the Domain Name Server system described in Schneider does not update the domain name records in the manner claimed. The various portions of Schneider's patent that the Examiner relies on for the updating capability merely provides IP address information associated with a host name. It is difficult to find a clear correlation of a first and second domain name record and the required function at the end of each independent claim on appeal of updating a second domain name record in a so-called whois database based on a first domain name record. Besides not indicating to the reader that a web browser maintains either a registrar database or a whois database, the Schneider patent does not indicate that the web browser itself may update a domain name in any database, let alone a whois database. Like we believe the ordinarily skilled artisan would consider, a mere list of URLs locally stored within a web browser does not necessarily correlate to the claimed whois database and the entry of a URL by a user is not a domain name record stored in a registrar database.

From our perspective, the correlations made by the Examiner in the statement of the rejection portion of the Answer as well as the responsive arguments portion are weak such as to be fairly characterized as stretching the teachings of the reference beyond reasonableness in the art and even a broadest reasonable interpretation of the claims mapped to Schneider. Although the Examiner has pointed to portions of Schneider that relate to identifiers, the updating capability that is ultimately the aim at the end of each independent claim is based upon the use of an audit file with its corresponding identifiers. The unique identifiers of the audit file are derived from the registrar database as claimed and therefore provide a base for retrieving corresponding information relating to first domain name records in the same database as well as in the so-called whois database. Although some comparisons may be performed within Schneider, they are not of the type that are required by the independent claims on appeal, thus not yielding the updating function at the end of these claims of updating a second domain name record in a whois database based upon a first domain name record implicitly within the registrar database.

Thus, we reverse the rejection of each independent claim 21, 31, and 41 and their respective dependent claims as being anticipated by Schneider.

#### NEW REJECTION UNDER 37 C.F.R. § 41.50(b)

Within the provisions of 37 C.F.R. § 41.50(b) we reject claims 21 through 40 as being directed to non-statutory subject matter within 35 U.S.C. § 101.

As to independent method claim 21, besides being directed to operations upon pure data structures per se as abstract concepts, the method is not recited to be done in or by a machine or otherwise recite a machine or computer implemented method, thus presenting a situation where a human being may perform the method steps recited. If it may be fairly stated that the method may produce a concrete, useful, and tangible result, the result is still operations upon data constructs or data structures themselves. There is no transformation of any underlying tangible subject matter to a different state or thing. Note the reasoning in *In re Comiskey* 499 F.3d 1365, 1377-79 (Fed. Cir. 2007). These considerations flow through to dependent claims 22 through 30.

In a corresponding manner, we reject the computer-readable medium independent claim 31, which in essence recites the same methodology in independent claim 21. The computer-readable medium is not positively recited to be used or executed by the noted processor to perform a methodology but merely that it is potentially “to be executed” by a processor. Based on the discussion at Specification pages 20 and 21 in paragraph [076], the claimed medium is disclosed to include transmission media in the form of acoustic or light wave energies. The claim does not positively recite an article of manufacture on which the method is to be embodied. Note the reasoning in *In re Nuijten*, 500 F.3d 1346, 1359 ( Fed. Cir. 2007). This reasoning is followed through with dependent claims 32 through 40.

In summary, we have reversed the Examiner's rejection of claims 21 through 50 under 35 U.S.C. § 102. Further, we have within 37 C.F.R. § 41.50(b) entered a new ground of rejection against claims 21 through 40 as being directed to non-statutory subject matter.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (2007). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review." 37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED  
37 C.F.R. § 41.50(b)

Appeal 2008-0845  
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